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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/988,181

12/10/1997

SHINICHI OSHIMA

Q48708

7161

7590 10/31/2007
SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE N W
WASHINGTON, DC 20037

EXAMINER

TRIMIEW, RAEANN

ART UNIT	PAPER NUMBER
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3711

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/988,181
Filing Date: December 10, 1997
Appellant(s): OSHIMA, SHINICHI

MAILED
OCT 31 2007
GROUP 3700

Bhaskar Kakarla
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 20, 2006 appealing from the Office action mailed September 21, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application 09/060,960, affirmed by BPAI (3/19/03)

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,676,975

ANDERSON

7-1928

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (1,676,975). Anderson discloses a golf ball box comprising a box body and a cover or lid fitted over the box (item 15, fig. 1). The box further includes indicia printed on the box explaining the novelty of the box or advertising. Applicant also claims indicia on a box. However, the indicia are not considered patentable because it is not functionally related to the substrate (box). See In re Miller 164 USPQ 46. Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art, see MPEP 2112.01 III. The rejection is also based on an application previously affirmed by the BPAI, 09/060,960. One of ordinary skill in the art would vary the indicia on the box to convey the desired message to the user.

(10) Response to Argument

The instant invention is a golf ball box comprising a cover and section on the cover comprising indicia. The indicia provides information to the user with regard to product inside the box, which in the instant case is a golf ball. As stated by Appellant, the application has been reviewed and reversed by the BPAI. However, new prior art is cited and applied against the claims. Anderson et al discloses a golf ball box for packaging golf balls. The box includes a cover and indicia on the surface of the cover as shown in figure 2. The indicia provides information about the product inside the package, see figure 2 where the indicia reads 'golf ball' etc. The question before the BPAI is whether or not the indicia is functionally related to the product. MPEP 2112.01 III states, 'Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).'. In order to interpret MPEP 2112.01 III indicia and a product must be present. In the instant case Appellant claims a box but does **not** claim the golf ball inside the package. Therefore the product to which the indicia must be functionally related to is the box. As shown in the claims the indicia is only focused on the golf balls or objects inside the box and not the box itself. Since the indicia does not provide information with regard to the claimed product it should not be considered functional. While Appellant's claims are very intricate and detailed they do not mention the claimed product or box. Appellant argues the indicia provides information about the golf balls (not the box) allowing the consumer to choose

the best golf ball suited for him or her. Anderson also includes indicia providing information to the user just as any other box containing products, such as a food box comprising nutritional facts or ingredients. The indicia is not functionally related to the box but simply describes the product inside the box.

Appellant further argues *In re Gulack* 703 f.2d 1381 (Fed Cir. 1983) supports the instant invention by stating, "the critical question is whether or not there exists any new and unobvious functional relationship between the printed matter and the substrate.". Again the printed matter in the instant case does not provide any information with regard to the substrate or box.

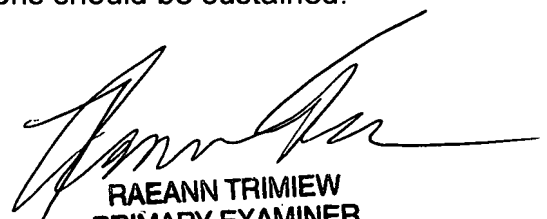
In conclusion, it is submitted the instant the instant invention comprising a golf ball box and indicia is not patentable over Anderson. Anderson discloses a golf ball box comprising indicia. It is further submitted the indicia is not functional to the substrate or box and should not be given patentable weight. The rejection is also based on an application previously affirmed by the BPAI, 09/060,960.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein (09/060,960).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

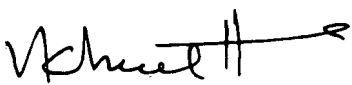


RAEANN TRIMIEW
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700

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Art Unit: 3711

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Conferees:

 (Vishu K Hendiretti)



EUGENE KIM
SUPERVISORY PATENT EXAMINER

October 13, 2006